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REMARKS

Claims 1-19 and 21-49 were previously presented in the above-identified application. Upon entry of this amendment, which amends claims 1, 5, 12, 13, 16, 21, 22, and 27, and cancels claims 14, 25, 26, 28-31, and 33-37, claims 1-13, 15-19, 21-24, 27, 32, and 38-49 remain pending. The Applicant respectfully requests reconsideration of the rejections in view of the following remarks. No new matter has been added with this amendment.

This Amendment incorporates into claim 22 allowable subject matter from now canceled claims 25 and 26. Applicant notes that previously presented claims 38-49 have been deemed allowable. Claims 5, 12, 13, 16, and 21 include minor amendments to clarify the language of those claims.

Section 102(e): Gummin.

Claim 1 and dependent claims 2-3, 14-15, 17-18, and 21 have been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,326,707 ("Gummin"). Claim 1 has been amended to incorporate allowable subject matter similar to that of claims 22, 25 and 26, as well as other elements that are not shown or suggested by Gummin. For example, amended claim 1 now recites that "at least the central portion of one SMA wire of the SMA wires is . . . external to the first surface of the heat sink, . . . and an end portion of the one SMA wire is . . . external to the recess[.]" As another example, claim 1 now recites that "the rigid parallel elongate members of the actuator constitute the heat sink." Gummin fails to disclose or suggest each of these elements. Furthermore, claim 1 has been amended to include additional patentable subject matter. For example, claim 1 now also recites: "a depth of the recess below the first surface is a function of at least a dimension of the one SMA wire and a surface area of the recess," the disclosure of which is generally located from p. 17, line 7 to p. 18, line 25 of the Specification. As Gummin fails to disclose or suggest each of the elements set forth in claim 1, Applicant respectfully submits that claim 1 is now in condition for allowance. Claims 2-3, 14-15, 17-18, and 21 depend from allowable independent claim 1 and thus are patentable for at least the same reasons. Therefore, withdrawal of the §102(e) rejection in connection with these claims is respectfully requested.

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Section 102(e): MacGregor.

Claim 1 and dependent claims 2-19 have been rejected under 35 U.S.C. §102(e) as being anticipated also by U.S. Patent No. 6,574,958 ("MacGregor"). Claim 1 has been amended to incorporate allowable subject matter similar to that of claims 22, 25 and 26, as well as other elements that are not shown or suggested by MacGregor. Applicant submits that claim 1 is now in condition for allowance for similar reasons set forth above in distinguishing amended claim 1 with respect to Gummin. Claims 2-19 depend from allowable independent claim 1 and thus are patentable for at least the same reasons. Therefore, withdrawal of the §102(e) rejection in connection with these claims is respectfully requested.

Section 102(b): Jacob.

Claim 27 and dependent claims 28-32, were held rejected under 35 U.S.C. §102(b) as being anticipated also by U.S. Patent No. 4,027,953 ("Jacob"). Claim 27 has been amended to incorporate allowable subject matter similar to that of claims 22, 25 and 26, as well as other elements that are not shown or suggested by Jacob. For example, amended claim 27 now includes a "rigid member being one of a number of rigid parallel elongate members . . . such that the stroke of the actuator is substantially equal to the sum of the stroke of the SMA wires." As another example, claim 27 now recites that "at least a portion of the shape memory alloy wire [is] external to the recess[.]" Jacob fails to disclose or suggest each of these elements. Furthermore, claim 27 has been amended to include additional patentable subject matter. For example, claim 27 now also recites that "at least the first heat transfer mechanism depends on one or more of the following: a dimension of the shape memory alloy wire, a dimension of the rigid member, a distance between the central portion and the rigid member, and a thermal property for the rigid member and the SMA wire[.]" the disclosure of which is generally located from p. 17, line 7 to p. 18, line 25 of the Specification. As Jacob fails to disclose or suggest each of the elements set forth in claim 27, Applicant respectfully submits that claim 27 is now in condition for allowance. Claim 32 depends from allowable independent claim 27 and thus is patentable for at least the same reasons. Therefore, withdrawal of the §102(b) rejection in connection with these claims is respectfully requested.

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Double Patenting: Claims 1-19 and 21-37.

Claims 1-19 and 21-37 have been rejected as not being patentably distinct over the claims of MacGregor in view of Gummin. A nonstatutory double patent rejection requires that the underlying references be combined so as to render the claimed invention obvious over the cited art. As discussed above, both MacGregor and Gummin fail to teach or suggest each element of the claimed combinations set forth in the amended independent claims. Hence, these references cannot be combined to support a determination that claims 1, 22 and 27 are obvious over the art of record. As such, Applicant submits that the double patenting rejection of independent claims 1, 22 and 27 is inappropriate. Therefore, withdrawal of the nonstatutory double patent rejection in connection with these claims is respectfully requested.

CONCLUSION

Applicant now amends the subject application for purposes of clarifying the claimed subject matter and expediting prosecution toward an early allowance. Therefore, Applicant reserves the right to reintroduce claims as previously filed. Should the Applicant choose not to reintroduce those claims, Applicant does not imply (and it should not be inferred) that the presently amended claim scope is the broadest to which it is entitled.

In sum, all of the independent claims and their associated dependent claims should now be in a condition for allowance, which is respectfully solicited. If the Examiner believes that any of the claims are not in a condition for allowance, the Examiner is encouraged to contact the undersigned to resolve any outstanding issues.

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Cooley Godward LLP
ATTN: Patent Group
Five Palo Alto Square
3000 El Camino Real
Palo Alto, CA 94306-2155
Tel: (650) 843-5000
Fax: (650) 857-0663

Respectfully submitted,
COOLEY GODWARD LLP

By: KRB

Kenneth R. Backus, Jr.
Reg. No. 48,861